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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/695,523   | 10/28/2003  | Ben Huang            | WINN.65898          | 5398             |
| 27629  | 7590        | 03/31/2004           |                     |                  |
| FULWIDER PATTON LEE & UTECHT, LLP<br>200 OCEANGATE, SUITE 1550<br>LONG BEACH, CA 90802 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| BLAU, STEPHEN LUTHER   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3711   |             |                      |                     |                  |

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/695,523

Applicant(s)

HUANG, BEN

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/28/03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "the felt layers" in line 12. There is insufficient antecedent basis for this limitation in the claim. It appears that the words -- the backing layers -- would make sense.

### ***Specification***

3. The disclosure is objected to because of the following informalities: The status of the parent 10/107,502 needs to be updated (i.e. patent number).

Appropriate correction is required.

### ***Drawings***

4. The drawings are objected to because there are two sets of drawings which are different for figures 24-26 (See enclosure (1)). Sheet 7 appears to contain the wrong

Art Unit: 3711

drawings. It is requested that new sheets 7 and 8 be sent in with only one set of figures 24-26. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,629,901 in view of claims 1-25 of U.S. Patent No. 6,641,488.

Claims 1-9 of U.S. Patent No. 6,629,901 lack an upper surface of the polyurethane having friction enhancing pattern of a large number of repetitive shapes defining water collection interstices, an upper surface of the polyurethane layer being

Art Unit: 3711

densified and rendered substantially water-tight by heat embossing, and a backing layer of EVA.

Claims 1-25 of U.S. Patent No. 6,641,488 disclose an upper surface of the polyurethane having friction enhancing pattern of a large number of repetitive shapes defining water collection interstices (Claim 3), an upper surface of the polyurethane layer being densified and rendered substantially water-tight by heat embossing (Claim 1), and a backing layer of EVA (Claim 2). In view of Claims 1-25 of U.S. Patent No. 6,641,488 it would have been obvious to modify the grip of claims 1-9 of U.S. Patent No. 6,629,901 to have an upper surface of the polyurethane having friction enhancing pattern of a large number of repetitive shapes defining water collection interstices in order to reducing the slipperiness of a grip which is wet. In view of Claims 1-25 of U.S. Patent No. 6,641,488 it would have been obvious to modify the grip of claims 1-9 of U.S. Patent No. 6,629,901 to have an upper surface of the polyurethane layer being densified and rendered substantially water-tight by heat embossing in order to prevent a grip from absorbing water weight and affecting the swing weight of a club. In view of Claims 1-25 of U.S. Patent No. 6,641,488 it would have been obvious to modify the grip of claims 1-9 of U.S. Patent No. 6,629,901 to have a backing layer of EVA in order to utilize a backing layer available in the market place if felt is not available.

A terminal disclaimer for both of these references is required.

Art Unit: 3711

***Allowable Subject Matter***

7. Claims 1-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and Double Patenting set forth in this Office action. None of the prior art discloses or renders as obvious a golf grip having a layer of polyurethane being densified and rendered substantially watertight by heat embossing a friction enhancing pattern in addition to the other elements of structure claimed. Matsumura discloses an embossed surface. Matsumura does not disclose a watertight surface.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor S. Thomas Hughes whose telephone number is (703) 308-1806. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 25 March 2004

  
STEPHEN BLAU  
PRIMARY EXAMINER